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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,037	06/20/2003	Thomas G. Hill JR.	TEJ/0004	6401

36735 7590 03/23/2005

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EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,037

Applicant(s)

HILL ET AL.

Examiner

Zakiya N. Walker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-26 and 29-32 is/are allowed.
- 6) ☒ Claim(s) 1, 5, 17-20, 22 and 33 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6-16, 21, 27, 28 and 34-37 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11062003,08112003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68. The signature of inventor Deaton is missing.

Specification

2. The abstract of the disclosure is objected to because the term "the present invention" is stated in line 1. Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

4. Claims 17, 18, 20-22, 27, 28, and 34 objected to because of the following informalities:

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Claims 17 and 18 recite "the expander mandrel", which lacks antecedent basis. The term "expander" should be deleted.

Claims 20, line 3, the term "the flapper" lacks antecedent basis. it appears that claim 20 as well as claims 21 and 23 should be amended to depend from claim 19.

Claim 27, it appears that the claim should be amended to depend from claim 23.

Claim 34, it appears that at least claim 34 should be amended to depend from claim 33.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 17-20, 22, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickson et al.'315 or Meaders et al.'630 (both cited by applicant).

Dickson et al.'315 discloses an apparatus that includes a lockout tool 51 for locking a subsurface safety valve 30 in the open position, wherein the safety valve comprises a pressure containing body having a bore there through, a valve closure member (flapper 31) disposed in the bore moving between an open and a closed position, a flow tube 73 axially moveable in the body, a non-moveable seat 72 adjacent the valve closure member, and an actuating means for translating the flow tube

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longitudinally in the bore, said lockout tool comprising: an elongated housing 132, 150 adapted to fit inside the subsurface safety valve; a mandrel 133 moveable in the housing; at least one dog 110, which, upon controlled movement of the mandrel, engages and moves the flow tube in a direction to place the valve closure member in its open position; and a plurality of expander points 140 in substantially circumferential arrangement inside the housing, and adapted to move into radial engagement with an inside diameter of the flow tube after the at least one dog has moved the flow tube to open the valve closure member in its open position, said expander points being urged to move radially outward with sufficient force to yield and expand a diametrical portion of the flow tube into engagement with the non-moveable seat in the safety valve, thereby permanently locking the valve closure member in the open position. With respect to the depending claims, the reference teaches the limitations as claimed. With respect to method claim 33, the reference discloses the method as claimed.

Meaders et al.'630 discloses an apparatus that includes a lockout tool 74 for locking a subsurface safety valve 22 in the open position, wherein the safety valve comprises a pressure containing body having a bore there through, a valve closure member (flapper 56) disposed in the bore moving between an open and a closed position, a flow tube 52 axially moveable in the body, a non-moveable seat 61 adjacent the valve closure member, and an actuating means for translating the flow tube longitudinally in the bore, said lockout tool comprising: an elongated housing 68, 72 adapted to fit inside the subsurface safety valve; a mandrel 67 moveable in the housing; at least one dog, which, upon controlled movement of the mandrel, engages and moves

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the flow tube in a direction to place the valve closure member in its open position; and a plurality of expander points 100 in substantially circumferential arrangement inside the housing, and adapted to move into radial engagement with an inside diameter of the flow tube after the at least one dog has moved the flow tube to open the valve closure member in its open position, said expander points being urged to move radially outward with sufficient force to yield and expand a diametrical portion of the flow tube into engagement with the non-moveable seat in the safety valve, thereby permanently locking the valve closure member in the open position. With respect to the depending claims, the reference teaches the limitations as claimed. With respect to method claim 33, the reference discloses the method as claimed.

Allowable Subject Matter

7. Claims 23-26 and 29-32 are allowed.
8. Claims 2-4, 6-16, 21, 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 27 and 28 would be allowable if rewritten to overcome the objection(s) set forth in paragraph 3 of this Office action.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Tuesday-Friday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zakiya N. Walker
Primary Examiner
Art Unit 3672

ZW
March 18, 2005